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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,471	02/05/2004	Yuriy Grigorievich Shermolovich	514413-3870.1	7037

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EXAMINER

HABTE, KAHSAY

ART UNIT PAPER NUMBER

1624

DATE MAILED: 12/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/773,471

Applicant(s)

SHERMOLOVICH ET AL.

Examiner

Kahsay Habte

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 10,11 and 17-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 12-16 is/ejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/812,309.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/2/2005</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-19 are pending in this application.

Election/Restriction

2. Applicant's election without effective traverse of Group II, Claims 1-9 and 12-16 (drawn to pyridines i.e. X = CH) filed on 12/02/2005 is acknowledged. Claims 10-11 and 17-19 are withdrawn from prosecution.

Information Disclosure Statement

3. Applicant's Information Disclosure Statement, filed on 02/05/2004 has been acknowledged. Please refer to Applicant's copies of the 1449 submitted herewith.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toki et al. (US Pat. No. 5,360,806). Cited reference teach two compounds of interest: N-(methylsulfonyl)-4-(trifluoromethyl)-3-pyridinecarboxamide and N-[(dimethylamino)sulfonyl]-4-(trifluoromethyl)-3-pyridinecarboxamide (see compounds 102 and 105 at columns 33-34). Said compounds are closely analogous to that

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claimed here, for the same use when applicants' compounds of formula (I) has the following substituents:

$R^1 = CF_3$; $R^2 = R^3 = H$; $Y = O$; $n = 0$; $m = 1$ and R^4 or $R^5 =$ alkyl or substituted alkyl.

The only difference between applicants' compounds and the prior art compounds is that applicants' compounds have a double bond between N and S and the sulfur is attached to oxo group ($N=S=O$), but the prior art compounds have a single bond between the N and S and the sulfur is attached to 2 oxo groups ($N-SO_2$). It is well established that this structurally related structures (isomers) are prima facie structurally obvious even in the absence of a teaching to modify. The isomer is expected to be preparable by the same method and to have generally the same properties. This expectation is then deemed the motivation for preparing the isomers. This circumstance has arisen many times.

See: *Ex parte Englehardt*, 208 USPQ 343, 349; *In re Mehta*, 146 USPQ 284, 287; *In re Surrey*, 138 USPQ 67; *Ex Parte Ulliyot*, 103 USPQ 185; *In re Norris*, 84 USPQ 459; *Ex Parte Naito*, 168 USPQ 437, 439; *Ex parte Allais*, 152 USPQ 66; *In re Wilder*, 166 USPQ 545, 548; *Ex parte Henkel*, 130 USPQ 474; *Ex parte Biel*, 124 USPQ 109; *In re Petrzilka*, 165 USPQ 327; *In re Crownse*, 150 USPQ 554; *In re Fouche*, 169 USPQ 431; *Ex parte Ruddy*, 121 USPQ 427; *In re Wiechert*, 152 USPQ 249, *In re Shetty*, 195 USPQ 753.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 and 12-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention:

a. Claim 1 and claims dependent thereon are rejected because the phrase “R⁶... may optionally be mono- or polysubstituted” or “optionally be mono- or polysubstituted” is indefinite. In the absence of the specific moieties intended to effectuate modification by the “substitution” or attachment to the chemical core claimed, the term “substituted” renders the claims in which it appears indefinite in all occurrences wherein applicants fails to articulate by chemical name, structural formula or sufficiently distinct functional language, the particular moieties applicants regards as those which will facilitate substitution, requisite to identifying the composition of matter claimed.

a. In claim 1, the phrase “R⁴, R⁵ are identical....-C(LW)R⁷” is not clear. What is the definition of variable “L”?

c. In claim 1, it is shown in the chemical structure that a ring nitrogen can be attached to oxygen atom to form a quaternary nitrogen, but there is no counter ion to make the molecule neutral. Note that this is different from N-oxide, since the N and O

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are not datively bonded to each other. It is recommended that applicants delete the -
(O)n from the claims. There is no guidance or any working example in the specification.

d. In claim 12, the phrase "veterinary medicament" is not clear. Is this a compound or a composition claim? If it is a compound, it duplicates the compounds of claim 1. If it is a composition claim, it should be written in a composition claim language and it needs a carrier.

Claim Objections

6. Claims 1 and 6 are objected to because of the following informalities: the use of brackets "[]" in the claims is objected, since applicants use brackets to show deletion of materials in the claims. It is recommended that applicants replace the brackets with parenthesis "()" to overcome this objection.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte whose telephone number is (571) 272-0667. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kahsay Habte
Primary Examiner
Art Unit 1624

December 14, 2005